

REMARKS

Claims 1-62 are currently pending in this application. Claims 1, 5, 15, 16, 18, 20, 22, 32, 35, 47, 52, 57, 60, and 61 have been amended. Claims 4, 21, 48, 53, and 58 have been canceled. No new matter has been added by way of this Amendment.

Please note that several of applicant's claims, including claims 1, 15, 18, 32, 38, 43, 47, 52, 57, 60, and 61, have been amended to recite language that under recent case law is intended to state two or more choices in the alternative and to clarify that the previously recited language is not to be interpreted solely in the conjunctive. Thus applicant has substituted the disjunctive "or" for "and" before the last element in each alternative list so that the claim covers any one or more of the listed elements in the alternative. Namely, the phrase "at least one of A or B" is to be interpreted as including: "A," or "B," or "A and B." Also, the phrases "at least one of A, B, or C," "A, B, or C," and "A or B" are to be interpreted in the same manner. These amendments conform the claims with current case law on this subject.

Premature Final Rejection

Applicant respectfully submits that this application has not yet been given a complete examination per Patent Office guidelines. Specifically, as noted in applicant's prior Amendment, dated December 22, 2003, it appears that in the Examiner's First Office Action, dated March 11, 2003,¹ the Examiner copied his rejections from other office actions issued to related cases of the applicant. Specifically, the many pages of the First Office Action were not directed to any of applicant's claims in the present case – they were directed to one of the other sets of claims in one of the other two related cases. These cases share a specification, but the claims are distinct and are directed to entirely different aspects of applicant's invention. The Examiner's response to applicant's amendment was to issue a final rejection (hereinafter the "Final Office Action") on April 8, 2004, which applied Barnett et al., U.S. Patent No. 6,321,208

¹ The Examiner issued an administrative Office Action on December 1, 2003, requesting resubmittal of applicant's response because several of the insertion and deletion marks had been inadvertently removed from the response when filed. The Response to the March 11, 2003 First Office Action was refiled with correction marks on December 22, 2003.

("Barnett"), in a very cursory manner that did not even address many of the limitations of applicant's claims. Although, per the M.P.E.P. 706.07(a), it is typically current practice to make all second and subsequent actions final, such practice can only be valid if a proper first Office Action was made – which, in this instance, was not. Moreover, the Examiner noted in the Final Office Action, in response to applicant's arguments, that "Applicant's arguments as herein presented are not plausible and thus the present Office Action has been made Final." The Examiner did not even address applicant's arguments. This is not proper, and applicant respectfully requests withdrawal of the finality of the April 8, 2004 Office Action and an interview as soon as possible to advance prosecution. A formal Request for Interview has been submitted herewith. Applicant's note that per M.P.E.P. §713.09 and §714.12 normally, one interview after final rejection is permitted.

General Comments Regarding Amendments and Requested Entry

Accordingly, applicant has amended the claims to put each claim in a better form for appeal, and respectfully requests the Examiner to enter these amendments. Applicant has merely incorporated language from some of the dependent claims into the independent claims, has shortened some unnecessarily long phrases (*e.g.*, "transmitting data to cause display of" has been modified in many instances to "displaying"), and has clarified that prior use of the phrase (conceptually) "at least one of A, B, and C" was intended in its mathematical sense (logical 'OR' operation) and has been changed, to conform with recent case law to "at least one of A, B, or C." Thus, not only has no new matter been added, but every one of the amendments were phrases that were presented in the claims previously, and thus should have been 1) already used in the Examiner's search or 2) reasonably expected to have been claimed based upon previously presented language (*see, e.g.*, M.P.E.P. 706.07(a)).

Objections

In the final Office Action mailed April 8, 2004, the Examiner continued to request a descriptive, brief, and technically accurate title. Applicant has amended the title to conform to 37 C.F.R. § 1.72. Applicant notes that the Examiner has never explained or indicated what the

problem is with the title, so applicant invites the Examiner to please be more specific if the amended title is not sufficient to overcome the objection.

Rejections Under 35 U.S.C. §101

The Examiner has rejected claims 15-17, 37-41, and 47-51 under 35 U.S.C. §101 because, as he asserts, the phrase “in a computer system” in the respective preambles is insufficient to indicate that the recited acts of the method are performed by a computer system. The Examiner asserts that “the body of the claim do not refer to any device or hardware... [t]o this end, a relevant device or hardware... should be used in at least independent claims..” In this statement, the Examiner requires applicant to incorporate structure that is part of the computer system into the body of the claim to cause the preamble to be construed as limiting the body of the claim.

Applicant respectively disagrees and asserts that the law does not require method claims to explicitly incorporate the structure of a computer system into the body of the claims to comprise acts that are performed by a computer system. The Examiner’s analysis is not reflective of the law and flies in the face of well-known principles of claim construction and the PTO guidelines themselves for examining computer-related inventions.

Specifically, as explicitly guided by §2111.01 of the M.P.E.P, it is a well-accepted principle that “whether a preamble limits a claim is made on a case-by-case basis in light of the facts of the case” and that “a claim preamble has the import that the claim as a whole suggests for it.” *Catalina Mktg. Int’l v. Coolsavings.com*, 289 F.3d 801, 808 (Fed. Cir. 2002); *Bell Communications Research v. Vitalink Communications*, 55 F.3d 615, 620 (Fed. Cir. 1995). Further, “if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim” *Pitney-Bowes v. Hewlett-Packard* 182 F.3d 1298, 1305.

In the current application, applicant’s claims recite “A method in a computer system....” This language is not merely functional language that describes “intended use” of the method, but rather explicitly indicates that the acts of the method are performed by a computer system. This interpretation is directly supported by throughout the specification, which describes how the claimed steps are performed by a computer system.

Further, the Examination Guidelines for Computer-Related Inventions, Final Version, June 26, 1997 ("Guidelines"), dictate a similar result without even requiring recitation of language *anywhere* in the claim that explicitly refers to a computer system. The Guidelines clearly intend that where the specification indicates steps to be performed by a computer system, which are claimed as "A method for . . .," ***the PTO office personnel are to interpret such claims as a series of steps to be performed on a computer and not a manual process.***² The PTO office personnel are then to perform an analysis of whether the claimed steps are statutory, for example by "manipulat[ing] data representing physical objects or activities to perform a practical application," by "perform[ing] independent physical acts," or, if (seemingly) merely manipulates an abstract idea or solves a purely mathematical problem, the steps are "limited to a practical application." (*Guidelines*, Appendix, p. A-3, boxes 12-13.) Applicant's claims 15-17, 37-41, and 47-51 all include the manipulation of data that represents physical activities to perform a practical application, or the steps are limited to a practical application. For example, claim 15 recited the "retrieving an accounting of past activations of the at least two marks to determine frequency of selection . . . relative to another one." In addition, claim 37 recites "causing a shopping list to be printed." Both of these acts fall within the statutory subject matter definitions per the above test. Moreover, purely to advance prosecution, applicant has amended these

² The Guidelines explicitly state that the process for examination of such claims includes that office personnel "will review the complete specification, including the detailed description of the invention" and "should correlate each claim limitation to all portions of the disclosure that describe the claim limitation." Examination Guidelines, p. 2, 4. In the flowchart describing the examination procedures, the office personnel are to determine whether the claim recites "A Series of Steps to be performed on a computer" (Box 8 of the analysis) and, if so, conduct an analysis (Box 12 of the analysis) to determine whether the method "Performs Independent Physical Acts" (post-computer process activity) or "Manipulates Data representing physical objects or activities to perform a practical application" (pre-computer process activity) to determine whether the strictures of 35 U.S.C. §101 have been met. *Id.*, Appendix, p. A-3. In the many examples showing use of this flowchart, Box 8 is considered to have been met without any recitation of a computer system at all, because it is clear from a reading of the specification that the method steps are to be performed by a computer system and are not manual steps. *See, e.g., id.*, Processes-Page 2-4, where the language "A method for controlling the rear wheels of a four-wheel steering vehicle, comprising the steps of..." is properly construed to comprise a series of steps performed on a computer. There are additional similar examples in the Guidelines that follow that example.

claims beyond statutory requirements to recite that several of the acts operate “electronically” and that, in claim 15, the marks are “used to print a shopping list or to execute a logout command.” Therefore, applicant respectfully requests the Examiner to withdraw the §101 rejection.

Rejections Under 35 U.S.C. §102

The Examiner has rejected all of claims 1-62 over the Barnett reference. In essence, the Examiner “equates a coupon or coupon package, as disclosed by Barnett, to a mark or a symbol or graphical image representing a promotion associated with a product or service or brand name from a manufacturer or a retailer” and thus Barnett teaches applicant’s claims 1-62. Applicant respectfully disagrees.

Applicant adopts and reasserts herein his arguments set forth in the Amendment filed December 22, 2003. In addition, and in response to the Examiner’s assertion that Barnett et al. teaches the claimed invention, applicant respectfully submits the Examiner appears to be misunderstanding how Barnett operates and attributes characteristics to the Barnett reference that are simply not present in the reference. Moreover, the Examiner ignores the claim limitations explicitly recited by applicant’s claims.

Specifically, all of applicant’s independent claims 1, 15, 18, 32, 37, 42, 47, 52, 57, and 60-62 are directed to “brand-related marks” which are defined in the specification as trade marks or service marks and claimed as such. Moreover, each of these independent claims recites that “the at least two brand-related marks” are used to activate a command – specifically printing a shopping list or initiating a sign-off from the application (or a logout command). The frequency of such activation is then used as the metric to determining brand recognition – not as the Examiner suggests, how often a product is purchased. This is simply not what applicant is claiming. The Examiner appears to be refusing to give significance to the language of the claims that indicates what the brand-related marks are used for.

For example,

- claims 1, 18, 42, and 60 state “transmitting data to cause display of at least two brand-related marks as activation mechanisms to print a

shopping list” which have been amended to “displaying at least two brand-related marks as activation mechanisms to print a shopping list;”

- claims 15, 32, and 61 state “retrieving an accounting of past activation of the at least two marks” which have been amended to recite “retrieving an ... accounting of past activation of the at least two marks used to print a shopping list or to execute a logout command;”
- claims 37 and 62 state “displaying at least two brand-related marks as activation mechanisms to print a shopping list;”
- claims 47, 52, and 57 state “transmitting data to cause display of a plurality of brand-specific marks, which when selected initiate an application-specific command” which have been amended to recite “display a plurality of brand-specific marks, which when selected initiate an application-specific command to print a shopping list or to initiate sign-off from the application;”

A similar analysis can be performed on the recited language that determines relative consumer awareness based upon tracking the number of times each mark is used in the above manners because the tracking is based upon “marks” whose antecedent bases are provided in the steps recited above.

Although not necessitated by the Examiner’s rejection, applicant has amended these claims to incorporate the language from several dependent claims that the brand-related marks are either service marks, trade marks or both to even further clarify that these are “any marks” let alone file names for the coupon files (which are selected by a user in Barnett) or coupons. Therefore, there should be no confusion that applicant’s brand-related marks aren’t the same as “coupon files (marks) displayed on the web page, where they can be printed or permanently save for later retrieval” as argued by the Examiner. Whether or not coupons are displayed in Barnett so that they can be printed has nothing to do with the use of applicant’s brand-related marks as recited in the claims. The Examiner is not free to simply ignore portions of recited language or recited acts.

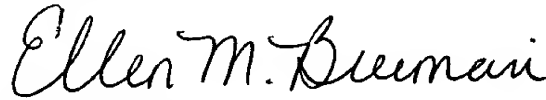
Nowhere in Barnett is there any teaching of using a service mark or a trade mark to activate the printing of a shopping list or to logout from the application, let alone using that the frequency of such activation to track brand recognition as recited by applicant's claims. In fact, Barnett teaches that the shopping list is printed by using the "shopping list function button 58" which "calls the shopping list generation routine 32g when selected by the user." (Barnett, 10:17-18.) Coupons can be selected for viewing, printing coupons etc. – they are not used to activate printing the shopping list as claimed by applicant. (They are merely "clipped" to be included in the shopping list produced by selecting the shopping list function button.) *Barnett*, 9:59-63. Also, there is absolutely no mention in Barnett of a logout command activated by anything. In addition, there is absolutely no mention in Barnett of "determining a frequency of [relative] selection" or "relative consumer awareness" based upon marks used for such activating printing or to execute a logout command. Thus, Barnett simply does not teach, motivate, or suggest the limitations of applicant's independent claims and hence all of the dependent claims that depend therefrom.

In addition, several of the dependent claims present limitations that have simply never been addressed by the Examiner. Specifically, claims 6 and 23 are directed to an "enticement" that "is associated with the at least two marks" to cause someone to "select a mark." Given that these at least two marks are used for the specific purposes recited in the independent claims (see analysis above), the enticement is associated with the at least two marks as used for activating printing of the shopping list or logging out. There is no discussion of any enticement in Barnett for selected anything having to do with these activities. In addition, claims 7-14 and 24-31 recite one or more "giveaways" associated with these "at least one of the at least two marks" and further limitations as to how the giveaways operate. There is absolutely no mention in Barnett of these recited aspects. Moreover, the Examiner has not addressed these recited aspects of applicant's claims in any office action. In fact, again the Examiner appears to have copied content from other office actions that in no reasonable way relates to these claims. Thus, these dependent claims should have at least been allowed if rewritten into independent form.

In closing, applicant respectfully requests the Examiner enter these amendments and to reconsider this application and its early allowance. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. The Examiner is invited to contact applicant's representative at (206) 622-4900 should the Examiner have any further questions.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

A handwritten signature in cursive script that reads "Ellen M. Bierman". The signature is written in black ink and is positioned above a horizontal line.

Ellen M. Bierman

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EMB:wt

Enclosures:

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Applicant Initiated Interview Request Form
Notice of Appeal

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